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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/570,917	02/12/2007	Jens Heinemann	HEINEMANN-8	3829
20151 7590 10/11/2011 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017			EXAMINER YIP, KENT	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 10/11/2011	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/570,917	<b>Applicant(s)</b> HEINEMANN ET AL.	
	<b>Examiner</b> KENT YIP	<b>Art Unit</b> 2625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 5) ☒ Claim(s) 27 and 29-53 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 27 and 29-53 is/are rejected.
- 8) ☒ Claim(s) 27 and 39 is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-302)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2011 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed July 18, 2011 have been fully considered but they are not persuasive.

Regarding claim 27, Applicant argues "the camera does streaming" (Remarks, page 7 paragraph 4) and "streaming images" (Remarks, page 7 paragraph 5) with support found in paragraph 0050 of the instant application publication (Remarks, page 7 paragraph 4).

Examiner notes that these two limitations which Applicant relies upon are not recited in the amended claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Next, Applicant argues the combination of Morgan and Manross requires payment up front (Remarks page 8). Examiner respectfully disagrees. The Manross reference was cited only to show that it was obvious to one of ordinary skill in the art to

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provide a user language selection when operating a kiosk. The payment feature is taught by Nihei.

With respect to the Morgan and Nihei combination, Applicant argues that “if payment is made in Nihei, no product is being produced. Thus, in order for the user to obtain the product, a further drive has to be activated” (Remarks, page 8). Examiner respectfully disagrees. The preliminary payment of \$1 is only required to activate an “additional drive” (Fig. 4 41 and Fig. 8 71). If no payment is inserted (Fig. 4 41=NO), the process proceeds to the next step (Fig. 4 44) where the image is selected from other sources and (Fig. 6 60) and a fee is only required after the product is inspected (Fig. 5 46-52).

Further, Applicant argues neither Morgan nor Nihei teach a camera which presents optimized images for user to select and insert into a motif (Remarks, page8). Examiner respectfully disagrees. Morgan teaches a camera/video camera 12 that captures images that can be properly focused and sharpened (p0062), have wrinkles smoothed (p0102), and red eye removed (p0062) and presented to a user to select while allow a user to change the background (p0102). Photoshop is also available to the user for further optimization (p0102). The above argument also applies to claim 39.

Applicant also argues Morgan does not do individual cards but only deck of cards, business cards or such (Remarks, page 8). Examiner respectfully disagrees. Morgan teaches that the invention can be used for post cards or match books and is not limited to playing cards (p0075, p0092).

***Response to Amendment***

***Claim Objections***

3. Claim 27 is objected to because of the following informalities: pre-amended step d does not match the previously presented version. Appropriate correction is required.

Claim 39 is objected to because of the following informalities: incorrect status identifier. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 50 recites the limitation "theft prevention unit" while the parent claims 39 and 48 recite the limitation "theft prevention means". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the

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subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27, 29-38, 52, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan (US 2004/0120008) in view of Manross et al. (US 6466830) and Nihei (US 7098942).

**Regarding claim 27**, Morgan teaches a method for creating individual pictures, cards and similar items comprising the steps (abstract, p0074-0075) in the following order (Fig. 4; Morgan teaches all the steps in order except for steps b and g which are taught by Manross and Niehi shown below):

a) explaining the method to a user on a preview window on a system screen (p0060, p0066-0067, p0118 Fig. 1-2 [14, 16], Fig. 4 [2]);

c) selecting a motif for the picture, card or item from one or more motifs stored in the system, and embedding the motif in a layout for the picture, card or item (p0102 Fig. 4 [5-7]; background can be changed);

d) recording one or more portraits of the user by a video camera (p0062 12 Fig. 4 [5-7]) having an optimization function for presenting a finite number of optimized portraits to the user (p0062, p0101; one or more sharpened or properly focused images of the user is/are captured); wherein the user is selecting an optimized portrait and embedding the optimized portrait in the layout for the picture, card or item (p0101; user selects images depending on preference);

e) integrating a desired text into the layout (p0100 Fig. 4 [8]);

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f) selecting to print, send or store a ready to output product on the screen after the product is either edited or corrected by repeating at least steps c) to e) (p0102, p0120-0122 Fig. 4 [9]);

h) receiving the outputted finished product (Fig. 4 [14]).

Morgan does not explicitly teach b) activating a communication and language selection and selecting the language for further transaction by the user and the picture, card or item to be created;

g) activating the billing and payment function.

Manross teaches b) activating a communication and language selection and selecting the language for further transaction by the user and the picture, card or item to be created (col 2 lines 43-54 Fig. 3 25; language selection is performed early in the process before image is captured).

Morgan and Manross are in the same field of endeavor of photo kiosk. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the photo kiosk of Morgan to include a multiple language selection means as taught by Manross allowing customers who select a more suitable language to operate the kiosk.

Nihei teaches g) then activating the billing and payment function (col 6 lines 8-15 Fig. 5 52; payment is activated right before printing).

Morgan and Nihei are in the same field of endeavor of photo kiosk. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the photo kiosk of Morgan to include a fee calculating and

collecting means ability as taught by Nihei to more accurately determine costs based on user desired print settings.

**Regarding claim 29**, Morgan in view of Manross and Nihei teach the method according to claim 27, wherein a format is selected which is a DP stream in progressive recording mode (Morgan p0062).

**Regarding claim 30**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein the user has an opportunity to select a suitable image through manual selection (Morgan p0101).

**Regarding claim 31**, Morgan in view of Manross and Nihei teach the method according to claim 27, wherein the user is offered an interaction element for selecting an individual image (Morgan p0101).

**Regarding claim 32**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein during automatic selection, images of optimal quality are selected (Morgan p0062, p0101).

**Regarding claim 33**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein the user is illuminated by an LED light during recording of the video stream (Morgan p0096 Fig. 1-2 34, p0067; it would have been obvious to use LEDs [0067] in the light bar as a source of light)

**Regarding claim 34**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein a user can select from at least four images of the video stream (Morgan p0101).



**Regarding claim 35**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein one or more images are displayed for viewing on a screen for preview (Morgan p0101).

**Regarding claim 36**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein the finished product is printed out (Morgan p0072-0082), sent as an e-mail, saved on storage media or saved to an online database offered by the system (Morgan p0101, p0109, p0111).

**Regarding claim 37**, Morgan in view of Manross and Nihei teach the method of claim 36, wherein the layouts are selected from external stationary (Morgan p0091) or mobile media or online databases.

**Regarding claim 38**, Morgan in view of Manross and Nihei teach the method of claim 36, wherein transfer means are used for interfacing with internet, wireless connection or external peripheral devices (Morgan p0108-0109, p0111).

**Regarding claim 52**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein the motif stored in the system is supplied by a kiosk (Morgan p0102; the background image could be stored in a memory device in the kiosk).

**Regarding claim 53**, Morgan in view of Manross and Nihei teach the method of claim 27, wherein the motif stored in the system is supplied by the user (Morgan p0102; the background image can be altered (supplied) by a user).

6. Claims 39-48, 50, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan (US 2004/0120008) in view of Jones (US 2002/0154327).

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**Regarding claim 39**, Morgan teaches an interactive machine for the individual design of pictures, cards, postcards and similar items (p0060, p0075 Fig. 1-3) comprising at least:

- a) a monitor (p0066 [14]);
- b) a camera with an adjustment apparatus (p0062-0065 [12]); wherein the camera has editing means for displaying a mirror image preview image, and means for presenting optimized portraits to a user for selecting one or more of the optimized images (p0062, p0101; one or more images of the user is/are captured where the images can be properly focused and sharpened (p0062), have wrinkles smoothed (p0102), and red eye removed (p0062) and presented to a user to select)
- c) a lighting unit (p0067, p0096 [34]);
- d) means for operating the machine (p0067 [16]);
- e) at least one interface for communication with external storage media and internet connection (p0108-0109, p0111);
- f) an integrated DP system comprising at least one internal storage unit (p0062, p0101);
- g) an output apparatus for creating at least one of, the picture and the cards (p0082 [18]);
- h) a payment unit (p0098 [38, 40]);
- j) a power supply (p0114 [10]);
- k) means for location-independent placement of the machine (p0110 [10]);
- l) theft prevention means (p0099);

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m) a remote maintenance unit (p0108).

Morgan does not explicitly teach i) a postage unit.

Jones teaches i) a postage unit (p0028 and p0033).

Morgan and Jones are in the same field of endeavor of photo kiosk. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the postcard printing photo kiosk of Morgan (p0075) to include a means to print postage as taught by Jones that provides a user a convenient method of creating a stamped postcard.

**Regarding claim 40**, Morgan in view of Jones teaches the machine of claim 39, wherein the camera includes a digital video camera for generating a video stream (Morgan p0062).

**Regarding claim 41**, Morgan in view of Jones teaches the machine of claim 39, wherein the lighting unit includes a photometer and a plurality of LED diodes for generating constant light for illumination of the user (Morgan p0096 Fig. 1-2 34, p0067; Examiner takes official notice that it would have been obvious to one of ordinary skill in that art at the time of invention that a light bulb or LEDs can be a source of light.).

**Regarding claim 42**, Morgan in view of Jones teaches the machine of claim 39, wherein the monitor is a touch screen monitor (Morgan p0066-0067).

**Regarding claim 43**, Morgan in view of Jones teaches the machine of claim 39, wherein the machine is operated by at least one of, a keyboard (Morgan p0067) and a joystick.

**Regarding claim 44**, Morgan in view of Jones teaches the machine of claim 39, wherein the output unit is a thermo sublimation printer (Morgan p0072 [18]).

**Regarding claim 45**, Morgan in view of Jones teaches the machine of claim 39, wherein the interface is suitable for various storage media (Morgan p0097, p0109, p0111).

**Regarding claim 46**, Morgan in view of Jones teaches the machine of claim 39, wherein an additional power supply in the form of a solar module is provided and for charging batteries (Morgan p0114).

**Regarding claim 47**, Morgan in view of Jones teaches the machine of claim 39, wherein the machine is provided with wheels, coasters or a carrying appliance (Morgan p0110).

**Regarding claim 48**, Morgan in view of Jones teaches the machine of claim 39, wherein the theft prevention means include at least one of physical attachment of the machine at the location (Morgan p0099) and radio signals that are acoustically or visually perceptible or via radio.

**Regarding claim 49**, Morgan in view of Jones teaches the machine of claim 39, wherein the remote maintenance unit functions by wireless communications or via cables (Morgan p0108).

**Regarding claim 51**, Morgan in view of Jones teaches the machine of claim 39, wherein the machine has surfaces for carrying advertisement that are background illuminated or is an electronic advertising panel (Morgan p0105).

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7. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan (US 2004/0120008) in view of Jones (US 2002/0154327) and Millet et al. (US 2004/0085449 continuation of No. 09/464221 filed 12/15/1999).

**Regarding claim 50**, Morgan in view of Jones teaches the machine of claim 48.

Morgan does not explicitly teach wherein the theft prevention unit features a motion sensor for the detection of approaching persons.

Millet teaches wherein the theft prevention unit features a motion sensor for the detection of approaching persons (p0056).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Morgan's means of kiosk security (p0099) to include a motion detector as taught by Millet (p0056) that automatically monitors activity thus improving security.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KENT YIP whose telephone number is (571)270-5244. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:00 PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sudhanshu Pathak can be reached on (571) 272-5509. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. Y./

Examiner, Art Unit 2625

/James A Thompson/

Acting SPE of Art Unit 2625